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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,100	03/03/2004	Giuseppe Maio	1610-100	4098
86902	7590	08/29/2010	EXAMINER	
J. Rodman Steele			PURDY, KYLE A	
Novak Druce & Quigg LLP			ART UNIT	
525 Okeechobee Blvd			PAPER NUMBER	
Suite 1500			1611	
West Palm Beach, FL 33401			MAIL DATE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/792,100

Applicant(s)

MAIO ET AL.

Examiner

Kyle Purdy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 7-9 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7-9 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

No joke- aDETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the arguments filed on 6/25/2010.
2. Claims 1, 2, 4, 7-9 and 14-16 are presented for examination on the merits. The following rejections are made.

Response to Applicants' Arguments

3. Applicants arguments filed 6/25/2010 regarding the rejection of claims 1, 2, 4, 7-9 and 14-16 made by the Examiner under 35 USC 103(a) over Nara et al. (US 4536405) in view of Mouglin et al. (US 5851517), Gough et al. (US 5580550) and Alwattari et al. (US 5874072) have been fully considered but they are not found persuasive and the rejections are **MAINTAINED** for the reasons of record in the office action mailed on 2/26/2010.

4. In regards to the 103(a) rejection, Applicant asserts the following:

A) The polyisoprene is produced by a comminuting and depolymerizing process;

B) The present cosmetic composition employs linear polyisoprene structures, not cyclic as Nara's polyisoprene; and

C) The present composition has improved properties over the prior art, and is therefore allowable.

5. In response to A, the fact that the polyisoprene is comminuted and depolymerized does not distinguish the claims. The final polyisoprene product, according to the claims, possesses a MW of between 100,000 and 4,000,000. Thus, any polyisoprene with a MW within this range reads on the limitation. Nara teaches including polyisoprene in their cosmetic composition but fails to teach any corresponding MW. Gough however teaches a cosmetic composition which suggests

employing polyisoprene with a MW of between 40,000 to 200,000. It's taught that polyisoprene is useful for providing the cosmetic composition with the ability to impart more tactile and visual benefits as well as imparting a thicker feel and enhanced body when applied to eye lashes. See MPEP 2144.05. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. Any ordinary person would have readily envisage employing polyisoprene possessing a MW of that being claimed with a reasonable expectation in providing benefit to the final cosmetic composition.

6. In response to B, Applicants argument is not persuasive. Applicants claim states "a polyisoprene obtainable by the process comprising the steps of a) comminuting a solid polyisoprene with a molecular weight of between 100,000 and 4,000,000 and b) depolymerising the comminuted solid polyisoprene of step a) to a molecular weight within the above range". The claims do not state that the polymer is linear, nor do they state that the polymer is not cyclic. Instead, language is used which is essentially a product by process. As such, it's the position of the Examiner that a polyisoprene produced by the process is a polyisoprene identical to Nara and Gough and absent any data/evidence otherwise Applicants polyisoprene is believed to be the same as that taught in the art. As of now, the claims simply require a polyisoprene polymer to a MW of between 100,000 to 4,000,000.

7. In response to C, the data provided are for polyisoprene and polyisoprene latex. None of the cited art employs polyisoprene latex therefore arguments of improved properties are not going to be persuasive. Currently, the cited references of Nara and Gough use polyisoprene, not polyisoprene latex. Applicant argues that there is a structural difference between the instant polyisoprene and the polyisoprene of the art, i.e. linear vs. cyclic. However, absent any

evidence, the polyisoprene of the art is viewed as structurally/chemically the same as the polyisoprene of the instant invention. Applicants argument is not persuasive.

Maintained Rejections, of Record
Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1, 2, 4, 7-9 and 14-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Nara et al. (US 4536405; published 08/20/1985) in view of Mougin et al. (US 5851517; published 12/*22/1998), Gough et al. (US 5580550; of record) and Alwattari et al. (US 5874072; of record).

12. Nara is directed to make-up compositions, i.e. eye make-up. A cosmetic formulation is disclosed which includes isoparaffin (42.6% by weight), microcrystalline wax (5% by weight), aromatic hydrocarbon resin (5% by weight) and organic modified montmorillonite (i.e. Bentone-18) (2% by weight) (see Example 4). Exemplified aromatic hydrocarbon resin include polyisoprene (see Table 2, #73-75). Moreover, Table 3 teaches various formulations for determining benefits of the resins discussed under Table 2. The composition comprises black iron oxide (25% by weight), wax (15% by weight), polyisoprene (10% by weight) and liquid paraffin (50% by weight). The composition showed fair oil resistance, but excellent water resistance and adhesion (see Table 3, #74). It's noted that both compositions are substantially anhydrous.

13. Nara fails to teach the molecular weight of the polyisoprene. Nara also fails to teach the organic-modified clay as being disteardimonium hectorite (i.e. Bentone 38) and the solvent as being isododecane.

14. Mougin is directed to non-aqueous cosmetic compositions. The composition is to have an oily component. Exemplified oils include isododecane, liquid paraffin and volatile isoparaffins (see column 3, lines 40-45).

15. Gough is directed to cosmetic compositions containing polymeric resins. A preferred polymeric resin is that of polyisobutylene with a preferred MW of between 150 and 10,000,000

(see column 3, lines 25-50; see instant claims 1, 2 and 9). The amount of polyisoprene included in the composition is from 0.01 to 20% (see column 4, lines 25-35). It's taught that such a resin is useful for providing the cosmetic composition with the ability to impart more tactile and visual benefits as well as imparting a thicker feel and enhanced body when applied to hair (i.e. lashes) (see column 2, lines 55-65).

16. Alwattari is directed to cosmetic compositions which comprise various clays. The clays are taught to be useful in a variety of systems, including that of anhydrous compositions. It's taught that the organophilic clays are useful for imparting a water resistance to the applied cosmetic composition. Exemplified oil dispersible clays comprise quaternium-18 bentonite such as Bentone 38 (distearyldimethylbenzylammonium hectorite; i.e. distearyldimonium hectorite) (see column 6, line 3). The amount of the clay present in the composition may range from 0.05 to 20%.

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nara, Mougin, Gough and Alwattari with a reasonable expectation for success in arriving at a composition consisting of polyisoprene, disteardimonium hectorite, isododecane and other conventional excipients wherein the composition is substantially anhydrous. Nara fails to teach a MW for polyisoprene, however, it would have been obvious for any person of skill in the art to look to any other known composition which uses the same in an attempt to identify which MW ranges were disclosed as being useful for that composition. If the result was the identification of a value as instantly claimed, then that would be a result of ordinary skill and common sense, not one of innovation. The taught values are recognized as providing a thicker feel and enhanced body when applied to

hair as well as improved tactile and visual benefits. In regards to the amount of polyisoprene included in the composition, this would have been an obvious value to determine, especially in view of Nara teaching composition comprising 5% and 10% of the polyisoprene. With respect to the inclusion of a disteardimonium hectorite, this is obvious. As Nara stipulates the inclusion of quaternium -18 bentonite, an ordinary person would endeavor to use this and/or substances similar to it. Thus, if the result was the finding of Alwattaris teaching that quaternium-18 bentonite are functionally equal (or identical) to modified clays such as Bentone-38 (instantly claimed material), then this would have been a product of ordinary skill and common sense to modify Nara with its inclusion. Additionally, one would have been motivated to use disteardimonium hectorite in the mascara composition of Nara because Bentone-38 provides water resistance to the compositions. With respect to the requirement that the polyisoprene be comminuted, it is the position of the Examiner the comminuted polyisoprene is identical to polyisoprene which has not be comminuted. The resultant polyisoprene would still be polyisoprene with a molecular weight of somewhere between 2,000,000 and 4,000,000. The inclusion a process limitation for reducing polyisoprene particle size does not add any significant limitation to the claims which is not present or covered by the MW limitation. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
August 17, 2010*

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